

Application No.: 10/627149

Case No.: 57983US004

REMARKS

Claims 1–19 are currently pending in the present application. Claim 15 is now cancelled. Claim 1 is amended. Applicants kindly request entry of the amendment to claim 1 as well as the amendment to the specification. Favorable reconsideration of this application in light of the foregoing amendments, and the following remarks, is respectfully requested.

OBJECTIONS TO THE SPECIFICATION

The Applicants acknowledge the withdrawal of the specification objections designated (a)-(f) originally appearing in the Office Action dated November 4, 2004.

The Patent Office has persisted in its specification objection designated (e) in the November 4, 2004 Office Action, further suggesting in the Final Office Action dated April 13, 2005, that “perfluoroadipatc” at page 21, line 9, should be changed to “perfluoroadipate”. The Applicants contended in their response filed on March 4, 2005, that the original application as filed does recite “perfluoroadipate”. If there is a discrepancy, it may have originated in the Patent Office document reproduction process. Nonetheless, the Patent Office has repeated its request that the paragraph at page 21, line 9 of the specification be amended. Accordingly, the Applicants have submitted an amended paragraph to correct the above-indicated discrepancy.

The Applicants submit that no new matter has been added to the present application with the foregoing amendment to the specification. The objection raised relate to certain grammatical or typographical errors. In light of the foregoing amendments and remarks, the Applicants respectfully submit that the objection to the specification re-asserted in ¶ 1 in the Final Office Action has been overcome and kindly ask that it be withdrawn.

CLAIM OBJECTIONS

The Applicants kindly acknowledge the withdrawal of objection to claims 2 and 6 as indicated in ¶ 1 of the Final Office Action. With this withdrawal, there are no outstanding objections to the claims.

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CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)*Logothetis or Logothetis in view of Grootaert or Linert*

The Patent Office maintains its rejection, first raised in ¶ 4–9 of the Non-Final Office Action dated November 4, 2004, of Claims 1–4, 6–14 and 17–18 under 35 U.S.C. § 103(a) as assertedly unpatentable over Logothetis (US 4,983,697) [hereinafter ‘697] or Logothetis (US 4,972,038) [hereinafter ‘038] each individually in view of Grootaert et al. (US 6,730,760 B2) [hereinafter ‘760] or Linert et al. (US 6,737,489 B2) [hereinafter ‘489].

Logothetis or Logothetis in view of Gootaert or Linert and in further view of Tournut

The Patent Office also maintains its rejection, first raised in ¶ 10–11 of the Non-Final Office Action dated November 4, 2004, of Claims 5, 16 and 19 under 35 U.S.C. § 103(a) as assertedly unpatentable over ‘697 or ‘038 each individually in view of ‘760 or ‘489 and further in view of Tournut et al. (U.S. 4,025,481) [hereinafter ‘481].

APPLICANTS’ RESPONSE TO CLAIM REJECTIONS

In its summary of the Applicants’ arguments, at page 5, ¶8 of the Final Office Action, the Patent Office characterizes the Applicants’ position as follows: “In summary, a microemulsion is equivalent to pre-emulsion although they may have the same or similar particle sizes.” The Applicants respectfully traverse this characterization of the Applicants’ position. The Applicants have, in fact, taken the position that a microemulsion is not the equivalent to a pre-emulsion, even though they may have overlapping particle size ranges. As specifically explained at page 4, lines 20 to 33, a microemulsion differs from a pre-emulsion in that microemulsions are stable, isotropic mixtures of liquid fluorinated monomers, water, and the fluorinated surfactant. Unlike traditional *mechanically* stable pre-emulsions, which are opaque or cloudy in appearance, the *thermodynamically* stable microemulsions are visually transparent or translucent and are equilibrium phases.

In light of the discussion between the Applicants’ attorney and the Examiner on June 21, 2005, the Applicants have amended claim 1 to indicate that the microemulsions of the present claims are equilibrium phases.

The descriptions in ‘760 and ‘489 mention emulsions having a pot life (settling time) of at least 1 hour, more preferably at least 3 hours (see ‘760 at column 4, lines 18–30 and ‘489 at column 10, lines 55 to 63). However, the very fact that the emulsions described in ‘760 and ‘489

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indeed have pot lives (settling times) indicates the fact that they are mechanically stable, not thermodynamically stable. Pot life is defined in both '760 and '489 to mean the time required for 10% by weight of the monomer droplets to settle or separate out of the aqueous emulsion. If the emulsions provided in '760 and '489 were in equilibrium phases, monomer droplets would not settle or separate out of the aqueous emulsion. Thus, to speak of a "pot life" would be meaningless. It is only because the emulsions in '760 and '489 are not in equilibrium phases that the concept of pot life has any meaning to those descriptions. Therefore, the both '760 and '489 fail to teach, suggest or describe a microemulsion, as described in claim 1, wherein the microemulsion is an equilibrium phase.

According to the MPEP, "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP 2143 (emphasis added).

The prior art references relied upon by the Patent Office do not teach or suggest all of the claim limitations of original Claim 1. Applicants respectfully submit that the obviousness rejections are inappropriate because the Patent Office has failed to establish a prima facie case of obviousness by failing to show an aqueous microemulsion comprising a perfluorinated alkane solphonic or carboxylic acid or salt thereof, a liquid fluorinated monomer comprising a cure-site and optionally an inert liquid and highly fluorinated hydrocarbon compound wherein the microemulsion is in an equilibrium phase. Furthermore, the Patent Office has not shown a motivation to modify the prior art teachings in the prior art or the knowledge of one of ordinary skill in the art. Therefore, Applicants request that the rejection of Claim 1 be withdrawn.

Claims 2-4, 6-14 and 17-18 and claims 5, 16, and 19 each incorporate the limitations of Claim 1 and add patentable features thereto. Applicants submit that when Claim 1 is shown to be patentable over the prior art, Claims 2-4, 6-14 and 17-18 and claims 5, 16, and 19 are also. Applicants request that the obviousness rejection of Claims 2-4, 6-14 and 17-18 and 5, 16, and 19 be withdrawn.

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CONCLUSION

In view of the foregoing remarks, favorable reconsideration of the present application and the passing of this case to issue with all claims allowed is courteously solicited. Should the Examiner wish to discuss any aspect of this application, applicants' attorney suggests a telephone interview in order to expedite the prosecution of the application.

Respectfully submitted,

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Date

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